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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,337	04/25/2001	Charles Jack Fisher	X-12449A	7545

25885 7590 04/14/2003

ELI LILLY AND COMPANY  
PATENT DIVISION  
P.O. BOX 6288  
INDIANAPOLIS, IN 46206-6288

EXAMINER

WEBER, JON P

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/842,337

Applicant(s)

FISHER ET AL.

Examiner

Jon P Weber, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003 .
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 11-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                      6) ☐ Other: \_\_\_\_\_ .

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***Status of the Claims***

The response with amendments filed 27 January 2003 has been received and entered.

Claims 1 and 11-14 have been presented for examination.

***Election/Restrictions***

Newly submitted claims 13-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are drawn to a product which is not uniquely required for the practice of the method of claims 1 and 11-12; other formulations of protein C zymogen could presumably be used (if it were enabled).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 1 and 11-12 are considered on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and newly added 11-12 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is argued that the disclosure at page 6 does not admit use of only activate protein C and that at the term “protein C” reasonably includes both the activated form and the zymogen. It is urged that the discussion at page 8 allows a skilled artisan to distinguish between activated protein C and protein C. Hence, it is concluded that the use of the term “protein C” means the zymogen and any teachings involving activated protein C are asserted to apply to the zymogen. Finally, it is argued that the failure to provide a working example is not sufficient basis for lack of enablement.

At page 7, second full paragraph, the clear meaning of “protein C” is set forth. Here it is stated that “protein C” has anticoagulant, anti-inflammatory and profibrinolytic activities. **These properties are not present in the zymogen, which is inactive.** Contrary to the assertions in the response, “protein C” as used in the disclosure means the activated form not the zymogen. At page 8, the abbreviation “aPC” is used in describing the amounts to be administered in the same paragraph where “protein C” is stated. The clear cumulative conclusion is that “protein C”, whenever used alone, means activated protein C, and does not include or mean the zymogen.

The disclosure presents treatment with activated protein C. This form of protein C has enzymatic activity that is missing in the zymogen. There is no way to extrapolate a biological activity of treating viral hemorrhagic fever with the activated protein C to the biologically inactive zymogen. A person of ordinary skill in the art would not have a reasonable expectation that the very slow rate of activation *in vivo* as discussed in Bang et al. would be sufficient to provide therapeutic effectiveness. Regardless of what the disclosure may or may not say, the art

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clearly defines the zymogen and activated forms differently. It would be repugnant to the art to define them as having the same activity as argued.

In this case, the lack of a working example for the zymogen is a real problem. Inventions targeted for human therapy bear a heavy responsibility to provide supporting evidence because of the unpredictability in biological responses to therapeutic treatments. The standard of enablement is higher for such inventions because effective treatments for disease conditions are relatively rare, and may be unbelievable in the absence of strong supporting evidence. Claims drawn to pharmaceutically acceptable compositions and to methods of administering compounds to humans generally require supporting evidence because of the unpredictability in biological responses to therapeutic treatments. The instant specification is absent actual working examples of how the invention would treat an individual with viral hemorrhagic fever and a person of ordinary skill in the art has no basis to believe that the results obtained with the activated protein C translate to the inactive zymogen.

Applicant's arguments filed 27 January 2003 have been fully considered but they are not persuasive. The rejection under 35 U.S.C. 112, first paragraph is adhered to for the reasons of record and the additional reasons above.

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

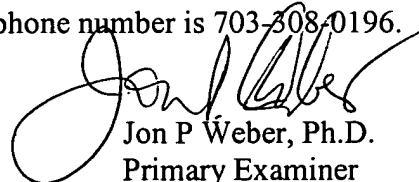
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 703-308-4015. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Jon P Weber, Ph.D.  
Primary Examiner  
Art Unit 1651

JPW  
April 7, 2003